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In re Application of :
Burbank et al. :
Application No. 09/981,525 : DECISION ON PETITION
Filed: October 16, 2001 : UNDER 37 CFR 1.78(a)(6)
Attorney Docket No. R0367.00401 :

This is a decision on the renewed petition under 37 CFR 1.78(a)(6), filed September 3, 2003, to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of a prior-filed provisional application. This decision also a corrects the decision mailed August 5, 2002, on the petition filed April 15, 2002 , where it granted petitioners request that the filing receipt indicate that Shabiz was a named inventor on filing.

The petition considered under 37 CFR 1.78(a)(6) is **DISMISSED**.

The petition filed April 15, 2002, where it requested that the filing receipt indicate that Shabiz was a named inventor herein on filing is **DISMISSED.**

WITH RESPECT TO THE PETITION UNDER 37 CFR 1.78(A)(6):

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after expiration of the period specified in 37 CFR 1.78(a)(5)(ii) and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

(1) the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) to the prior-filed application, unless previously submitted;
(2) the surcharge set forth in § 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant pending nonprovisional application was filed on October 16, 2001, which is not within twelve months of the filing date of the prior-filed provisional application, Application No.

60/076,973, which was filed on March 3, 1998, and for which priority is claimed. However, applicants also claim § 120 benefit of application No. 09/057,303 filed April 8, 1998, by way of application No. 09/196,125 filed November 20, 1998, which were filed within 12 months of the aforementioned provisional application. A reference to the prior-filed provisional application has been included in an amendment to the first sentence of the specification following the title.

However, the amendment is not acceptable as drafted since it improperly incorporates by reference the prior-filed application. Petitioners' attention is directed to Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (D.C. Cir. 1980), where the court drew a distinction between a permissible 35 U.S.C. § 120 statement and the impermissible introduction of new matter by way of incorporation by reference in a 35 U.S.C. § 120 statement. The court specifically stated:

> Section 120 merely provides a mechanism whereby an application becomes entitled to benefit of the filing date of an earlier application disclosing the same subject matter. Common subject matter must be disclosed, in both applications, either specifically or by an express incorporation-by-reference of prior disclosed subject matter. Nothing in section 120 itself operates to carry forward any disclosure from an earlier application. In re deSeversky, supra at 674, 177 USPQ at 146-147. Section 120 contains no magical disclosure-augmenting powers able to pierce new matter barriers. It cannot, therefore, "limit" the absolute and express prohibition against new matter contained in section 251.

In order for the incorporation by reference statement to be effective as a proper safeguard against the omission of a portion of a prior application, the incorporation by reference statement must be included in the specification-as-filed, or in an amendment specifically referred to in an oath or declaration executing the application. *See* In re deSeversky, *supra*. *Note also* MPEP 201.06(c).

Accordingly, before the petition under 37 CFR 1.78(a)(6) can be granted, a substitute amendment[1] excluding the provisional application from the incorporation by reference statement, along with a renewed petition under 37 CFR 1.78(a)(6), is required. That is, the incorporation by reference statement may properly include both prior non provisional applications, which themselves were incorporated by reference on the filing date herein, but may not also properly include the provisional application. Applicants' contention that the incorporation by reference of the prior non provisional application, which itself incorporated the prior provisional application served to incorporate herein the provisional as well is not well taken. Firstly, such would constitute an improper "double incorporation," as the prior non provisisonal incorporated the provisional. See MPEP 608.01(p)(1)(A). Second, as the provisional application was not pending when the instant application was filed, it cannot properly be incorporated by reference. See Id. Third, petitioners tacitly admit that the incorporation by reference statement that was herein present on filing did not specifically refer to the provisional; indeed no mention was made of the

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[1] *Note* 37 CFR 1.121

provisional application in question on the filing of the instant application. But see MPEP 201.06(c) under the caption "Incorporation by Reference"

AS TO THE CORRECTED FILING RECEIPT NAMING SHABAZ:

The decision of August 5, 2002, correctly noted (at 3) that applicants' itemized postcard receipt did not specifically itemize the number of pages contained in the orth or declaration, and that page 3 of 3 of the declaration, which identified Shabaz as a named inventor and, apparently, contained his signature was not herein present on filing. Indeed, the file contains a document prepared by the Office of Initial Patent Examination which indicates that, on filing, no page marked 3 of 3 was present. It necessarily follows that the petition erred where it indicated that a corrected filing receipt should show that Shabaz had in fact been named as an inventor herein on filing. That is, since applicants have not provided prima facie evidence that page 3 of 3 was present herein on filing, then the instant declaration did not comply with 37 CFR 1.63(d)(iv) which required that applicants file herein a copy of the declaration from the prior application which did name Shabaz as an inventor. As such, by operation of 37 CFR 1.41(a)(1), the 2 pages of the copy of the declaration from the parent file that were received on filing, and were signed by those three inventors, fixed the inventorship herein as: Burbank, Lubock, and Jones. See 37 CFR 1.41(a)(1); MPEP 210.03. It follows that applicants must present a petition under 37 CFR 1.48(a) and fee, to now add Shabaz as a named inventor. See MPEP 201.03. Accordingly, the decision of August 5, 2002 is **vacated** to the extent that it approved correction of the inventive entity in the absence of a grantable petition under 37 CFR 1.48 Likewise, the corrected fling receipt is **vacated** for the same reason, and for the additional reason that no decision on petition has yet approved applicants' belated claim for benefit of the provisional under 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(6). A proper, corrected filing receipt is enclosed for petitioner's convenience.

Further correspondence with respect to this matter should be addressed as follows:

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Any questions concerning this matter may be directed to Petitions Examiner Brian Hearn at (703) 305-1820.

Charles Pearson
Director, Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Enclosure: Corrected Filing Receipt